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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,427	07/18/2001	Gerbrad Pfaff	MERCK-2281	4109
23599 7590 10/29/2003				
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.				
2200 CLARENDON BLVD.				
SUITE 1400				
ARLINGTON, VA 22201				
			EXAMINER	
			YOON, TAE H	
ART UNIT		PAPER NUMBER		
1714				

DATE MAILED: 10/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/889,427

Applicant(s)

PFAFF ET AL.

Examiner

Tae H Yoon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 5-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 9-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

A proper Terminal Disclaimer is acknowledged.

Applicant's traversal of the restriction requirement is noted. Applicant asserts the rejoinder upon a finding of allowability of the product claims. However, it has no probative value since the restriction requirement was made **FINAL** in the last office action and since the process of claim does not yield the product of claim 1 since the precursor of the substrate becomes the metal oxide in claim 5 and two (or more) layers of metal oxides or metals coated thereon. Thus, said coating process neither yields three layers on the substrate nor recites particular refractive indices of said metal oxides. Also, metallic layer is not required in claim 5 and thus it raises issues under 35 USC 1st and 2nd PP.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is **NEW MATTER** rejection since the amendment reciting particular additional layers has no support in the originally filed specification.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 9-14 and 17-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Schmid et al (US 5,607,504).

Rejection is maintained for reason of record and following response.

Schmid et al teach multilayer nacreous pigments comprising layers (top to bottom) of a metal (copper or aluminum, col. 3, lines 54-62), a metal oxide (ZrO_2 or TiO_2 , col. 3, lines 1-2 and 36-44), a high refractive index oxide of Fe, Cr or Ti (col. 2, lines 49-59) and a low refractive index oxide of Si or Al (col. 2, lines 43-46).

The instantly recited "comprising" permits the presence of other layers and any coating order unless specified as in some claims. Said high refractive index oxide of Fe, Cr or Ti (col. 2, lines 49-59) meets the instant substrate and said layers of a metal (copper or aluminum, col. 3, lines 54-62), a metal oxide (ZrO_2 or TiO_2 , col. 3, lines 1-2 and 36-44) and a low refractive index oxide of Si or Al (col. 2, lines 43-46) meet the

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instant layers (iii), (ii) and (i), respectively. A stable polymer film at col. 2, line 67 meets the instant agricultural film absent further limitation since said agricultural is an intended use which has no probative value.

Furthermore, Schmid et al also teach a coating of said metal layer with iron oxide or titanium oxide (which would meet the instant substrate) yielding a (weak) self-color due to interference effects at col. 4, lines 10-13 which meets the instant pearl luster even though it possesses weak interference effects absent further limitation in the instant claim. Color changes taught at col. 4, lines 27-52 also meet the instant pearl luster. Said coated metal layer has average diameters from 1 to 200 μm and a thickness from about 0.1 to 5 μm (col. 4, lines 20-25). Other coating thickness is taught at col. 3, lines 45-53. Thus, the layer discussed in above pp 2 (said high refractive index oxide of Fe, Cr or Ti (col. 2, lines 49-59) meeting the instant substrate) would have average diameters from 1 to 200 μm inherently since the coating is on said metal layer has average diameters from 1 to 200 μm .

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not


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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H Yoon whose telephone number is (703) 308-2389. The examiner can normally be reached on Mon-Thu.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Tae H Yoon
Primary Examiner
Art Unit 1714

THY/October 24, 2003